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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|-----------------------|------------------|
| 10/576,332 | 04/18/2006 | Detlef Biernat | ZEI-3304/500343.20325 | 9711 |
| 26418 7590 01/14/2009 | | | | |
| REED SMITH, LLP | | | | |
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| EXAMINER | | | | |
| STULTZ, JESSICA T | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2873 | | | | |
| MAIL DATE | | DELIVERY MODE | | |
| 01/14/2009 | | PAPER | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,332

Applicant(s)

BIERNAT ET AL.

Examiner

JESSICA T. STULTZ

Art Unit

2873

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Svetliza et al US 5,966,196, herein referred to as Svetliza '196.

Regarding claim 5, Svetliza '196 discloses an illumination unit (Figures 1-2, 3A-B, illumination units 208/300) for fundus cameras and/or ophthalmoscopes (Abstract and Column 3, line 14-Column 4, line 45, wherein the device images the eye, Figures 1-2) comprising: an illumination source for emitting light (Column 4, line 48-Column 5, line 12, light source 304, Figures 3A-B); a front lens (lens 220 of imaging module 204, Figures 1-2) and individual light-conduction fibers or bundles of light-conduction fibers which extend into the area of the front lens (fibers 308) the fibers and the front lens being positioned such that they do not contact the eye being examined (Shown in Figures 1-2, Column 3, lines 30-35, wherein the imaging module 204 and illumination unit 208 are brought into close proximity to the eye without touching the eye), wherein the light emitted by the illumination source is coupled into the fibers (at fiber ends 306) and wherein ends of the fibers (308) are formed in such a way that, without the use of a scleral contact lens (Figures 1-2, 3A-B, wherein no scleral contact lens is used), the exiting light is projected on the sclera of an eye to be examined and transilluminates the sclera (Column 3, lines 30-35, Shown in Figures 1-2, 3A-B).

Regarding claim 6, Svetliza '196 further discloses that at least one light-conducting fiber or bundle of light-conducting fibers is provided and arranged in such a way that the light of the illumination source transilluminates the sclera in the nasal and temporal area (Shown in Figure 1-2, and 3A-B, wherein the fibers illuminate around the circumference of the cornea and thereby the nasal and temporal areas of the sclera).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svetliza '196, as applied to independent claim 5 above, and further in view of King US 4,575,208, herein referred to as King '208.

Regarding claim 7, Svetliza '196 disclose an illumination unit as shown above wherein the illumination source provides continuous illumination of the sclera for purpose of observation (Column 4, line 48-Column 5, line 12, wherein the illumination source 208/300 provides continuous illumination to eye, Figures 1-2, 3A-B) wherein the light of the continuous illumination source is imaged onto the sclera by an optical means (Shown in Figures 1-2, wherein the illumination source 208/300 provides illumination via lens 204) but does not specifically disclose that the illumination unit comprises an additional pulsed light source provided for electronic and/or photographic documentation in addition to the illumination source, which provides continuous illumination of the sclera for purposes of observation, wherein the

light of the continuous illumination source is imaged in the focal plane of the pulsed light source by an optical means. King '208 teaches of an illumination unit for fundus cameras and/or ophthalmoscopes (Column 1, lines 5-10, wherein a fundus camera is used to photograph the sclera of a patient's eye) comprising: an illumination source for emitting light (Column 3, lines 25-32, wherein the illumination source is "12", Figures 1-3); a front lens (lens "2", Figure 2); and a light-conducting fiber (Column 3, lines 33-66, wherein the source "12" is coupled into tube "20", Figures 1-5) which extends into the area of the front lens of the fundus camera (Column 3, lines 12-66, Figures 1-5); wherein the light emitted by the illumination source is coupled into the fibers and wherein ends of the fiber are formed in such a way that the exiting light is projected on the sclera of the eye to be examined and transilluminates the sclera (Column 2, lines 28-45) and further teaches that the illumination unit comprises an additional pulsed light source provided for electronic and/or photographic documentation (Column 3, line 33-Column 4, line 7, wherein the additional pulsed light source is strobe light "16" which provides a pulsed light for photography purposes, Figures 5-8) in addition to the illumination source which provides continuous illumination of the sclera for purposes of observation (Column 3, lines 25-33, wherein the light "12" provides continuous illumination of the sclera for focusing, Figures 5-8), wherein the light of the continuous illumination source is imaged in the focal plane of the pulsed light source by an optical means (Column 4, lines 39-66, wherein the strobe light "16"/"35" travels the same path as the focusing light "12"/"35" via a fiber optic cylinder "4"/"37", Figures 5-8). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the illumination unit of King '208 with that of Svetliza '196 for the purpose of providing focusing of the eye to be photographed/examined and

to avoid obliteration of a portion of eye due to reflections of light from the fiber optics (Column 4, lines 39-66).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Svetliza '196, as applied to independent claim 5 above, and further in view of Glynn et al US 5,297,554, herein referred to as Glynn '554.

Regarding claim 8, Svetliza '196 disclose an illumination unit as shown above, but does not specifically disclose that the ends of the light-conducting fibers or light-conducting fiber bundle located in the area of the front lens can be moved separately or jointly independent from the position of the fundus camera and/or ophthalmoscope. In the same field of endeavor of illumination unit for fundus cameras and/or ophthalmoscopes (Abstract) Glynn et al '554 teaches of an illumination unit (8) wherein the ends of the light-conducting fibers or light-conducting fiber bundle located in the area of the front lens can be moved separately or jointly independent from the position of the fundus camera and/or ophthalmoscope (Column 9, lines 10-23, wherein the fibers of illumination system 8 are movable independent of the light sensing means, i.e. ophthalmoscope, Figures 8-9). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of independently movable light-conducting fibers of Glynn '554 with the illumination unit of Svetliza '196 for the purpose of providing optical focusing of the light beam on the eye (Column 9, lines 10-23).

Response to Arguments

Applicant's arguments with respect to claims 5-8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JESSICA T. STULTZ whose telephone number is (571)272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jessica T Stultz
Primary Examiner
Art Unit 2873

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